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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,153	11/17/2003	Misao Kobayashi	D-1561	9449

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EXAMINER	
MORRISON, THOMAS A	

ART UNIT	PAPER NUMBER
3653	

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,153	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Thomas A. Morrison	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *7-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 11- 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *09/20/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-6 and 11-12 in the reply filed on January 10, 2005 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-6 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding the independent claim 1 and its dependent claims 2-6, claim 1 recites a switchback path disposed adjacent to the discharge outlet in a discharge direction. This appears to be inaccurate and is unclear. In particular, it is unclear what it meant by the recited discharge direction. With regard to claim 1, it is also unclear what is meant by the recited means for overlapping the one original with a next original. This claim would be better clarified if amended to recite a means to cause overlapping of the one original with a next original, or a means for controlling the apparatus to cause overlapping.

Claim 2 recites the limitation "overlap means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the original" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 and its dependent claim 12, claim 11 recites the limitation "the original" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,995,801 (Katsuta et al.). In particular, Katsuta et al. discloses all of the limitations of claims 1-5 and 11.

Regarding the independent claim 1, Figs. 36-38i show an original transport apparatus (20) for transporting originals, comprising:

an original tray (2101) for stacking the originals (D1, D2),

feed means (2103, 2104) disposed adjacent to the original tray (2101) for feeding the originals (D1, D2) stacked on the original tray (2101) one by one to a predetermined feeding position (Fig. 38b),

transport means (2201) disposed adjacent to the feed means (2103, 2104) for transporting one original (D1) from the feeding position (Fig. 38b) to a discharge outlet (Figs. 38b and 38c) through a reading position (190),

a switchback path (near 2904) disposed adjacent to the discharge outlet (Fig. 38c) in a discharge direction for switching back the one original (D1) to turn over the same,

a re-feed path (2905) disposed adjacent to the switchback path (near 2904) for returning the one original (D1) to the feeding position (Fig. 38d) after the one original (D1) is switched back in the switchback path (near 2904),

discharge means (2901) disposed at a downstream side of the switchback path (near 2904) for discharging the one original (D1) after the one original (D1) is read, and

means for overlapping the one original (D1) with a next original (D2) after two sides of the one original (D1) are read so that the one original (D1) after the two sides of the one original (D1) are read is sent to the feeding position via the switchback path (near 2904), is overlapped with the next original (D2) to pass through the reading position (190) without being read and is discharged by the discharge means (2901) via the discharge outlet. See Figs. 38f-38h for an understanding of the overlapping of D1 and D2.

Regarding the dependent claim 2, Figs. 38f shows that the overlap means overlaps the one original (D1) with the next original (D2) such that a leading edge (right side of D1 in Fig. 38f) of the one original (D1) is shifted rearwardly from a leading edge of the next original (left side of D2 in Fig. 38f) by a predetermined distance.

Regarding the dependent claim 3, the discharge means (2901) includes a pair of discharge rollers (2901a and 2901b) capable of rotating at different speeds for discharging the one original (D1) after the two sides are read. In particular, the speed of

the rollers (2901a and 2901b) is capable of being changed by changing the speed of the motor.

Regarding the dependent claim 4, Katsuta et al. discloses that the pair of the discharge rollers (2901a and 2901b) includes a first discharge roller (2901b) for contacting the one original (D1) after the two sides thereof are read, and a second discharge roller (2901a) for contacting the next original (D2) to be read next, the first discharge roller (2901b) rotating at a speed (V25) higher than that (V24) of the second discharge roller (2901a) in discharging (send to the tray) the original. In particular, column 40, line 65 to column 41, line 2 and column 41, lines 25-30 explain the relationships between V24 and V25. Specifically, V25 can be greater than V24. Moreover, the roller (2901b) will rotate at the speed (V25) of the holding rollers (2902) via contact with the moving original (D1) when the original (D1) is moved to the right in Fig. 38f, and the roller (2901a) will rotate at the speed (V24) to move the next original (D2) to the left at the same time. See column 42, line 55 to column 43, line 7 and Fig. 38f. As such, the roller (2901b) can rotate at a higher speed than roller (2901a) as claimed.

Regarding the dependent claim 5, the pair of the discharge rollers (2901a and 2901b) rotates in a reverse direction for switching back the next original (D2) and for transporting the next original to the reading position (190) after the one original (D1), the two sides of which have been read, passes the pair of the discharge rollers (2901a and 2901b). In order to be able to read the next original D2, the pair of discharge rollers (2901a and 2901b) will be reversed. See Fig. 38g.

Regarding the independent claim 11, Figs. 36-38i show an image reading apparatus comprising:

transport means (2103, 2104) for receiving originals (D1, D2) one by one, and transporting the originals (D1, D2) sequentially to a predetermined reading position (Fig. 38b),

reading means (190) for reading one original (D1) passing through the reading position (Fig. 38c),

a switchback path (near 2904) for switching back the one original (D1) read at the reading position (Fig. 38c) to change a moving direction thereof to turn over the original (D1),

discharge means (2901) for discharging the one original (D1) after the one original (D1) is read, and

control means (including 3000) for controlling the transport means (2103, 2104), the reading means (190) and the discharge means (2901) such that the one original (D1) is circulated twice through the switchback path (See Figs. 38a-38g) for reading two sides of the one original (D1) by the reading means (190); the one original (D1) is overlapped with a next original (D2) after the two sides of the one original (D1) are read and the one and next originals (D1, D2) are transferred to the reading position (190); and the next original (D2) overlapped with the one original (D1) is read by the reading means (190).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is 703-305-0554. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).